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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,553	01/23/2004	Jochen Von Der Hardt	010743.52910US	3212

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EXAMINER

PERRIN, JOSEPH L

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,553

Applicant(s)

VON DER HARDT ET AL.

Examiner

Joseph L. Perrin, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-10 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Examiner's Comments***

1. It is noted that in the amendment filed 06 September 2005, applicant cancelled claim 20. In the amendment filed 17 January 2006, applicant lists claim 20 with a status identifier of "original". Although such amendment is improper and constitutes a non-compliant amendment, in the interest of compact prosecution the Examiner has withdrawn claim 20 to examine the pending claims. Applicant is required to cancel claim 20 in the next Office action. Failure to comply may result in a non-compliant Office action.

### ***Response to Arguments***

2. In response to applicant's amendment, the claim objection and the rejection under 35 USC §112, second paragraph have been withdrawn. However, the amendment has resulted in a new rejection under 35 USC §112, first paragraph.

3. Applicant's arguments filed 17 January 2006 have been fully considered but they are not persuasive.

4. In response to applicant's arguments that KONONOV "does not disclose or suggest a test device for testing filters *external to the test device*", this is not persuasive because the filter being tested in KONONOV is external to all structural components of the testing device. Moreover, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the device of KONONOV is fully capable of performing such function and is readable on the claimed intended use of applicant. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danyl*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original)

5. In response to applicant’s argument that KONONOV does not disclose the newly recited “means for isolating”, this is not persuasive because the structure of KONONOV (i.e. valves) is fully capable of performing such function and is considered structures readable on the broadly claimed “means for isolating”. It is noted that the structure is fully capable of performing the intended use of “during cleaning”. Applicant is urged to structurally define the claimed invention over the prior art.

6. Regarding applicant’s language of “internal” and “external”, such terminology is considered relative terminology and does not significantly describe the claimed device to define over the prior art. The filter being cleaned/tested in KONONOV may be construed as being “internal” or “external” depending on relation to structure. For instance, since the filter of KONONOV is not inside the claimed structural components the filter of KONONOV reads on being “external” to the claimed device.

7. In response to applicant's arguments that KONONOV does not disclose or suggest internal volumes being "individually isolable during cleaning" this is not persuasive because KONONOV is fully capable of performing such intended use through the plurality of valves. Regarding applicants arguments to the filter housing not being isolable, it is noted that the features upon which applicant relies (i.e., separable filter housing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the filter housing must have the capability to open in order to remove or add a filter. Thus, such structure reads on applicant's claimed structure of "a filter connection for connecting the filter or filter system to be tested".
8. Accordingly, recitation of KONONOV reads on applicant's claimed invention.

### ***Claim Rejections - 35 USC § 112***

1. Claims 11-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added language "means for isolating" and "pressure sensor" are not described in the original disclosure and are considered new matter. The original disclosure does not describe any means for isolating. It is noted that the broader term "sensor" improperly broadens the scope of

the originally disclosed "meter" (designated as reference numeral 32) and therefore is considered new matter.

***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 11-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KONONOV (previously cited). Re claims 11-19, KONONOV discloses a device 8 having a CPU 13 controlling a plurality of pneumatic valves V1-V13 (having "an open state" and "a closed state") connecting a plurality of lines having "internal volumes" and external connections (various lines) connected to filter housing 10 which are capable of "isolating" the "internal volumes", a pressure sensor 46 isolable via operation of said valves, a cleaning supply (top left of Figure 1), a compressed air source (top left of Figure 1) which reads on an internal or external tank, and an external tank (tank 66 or cleaning liquid supply) (see Figure 1 and relative associated text, *i.e.* col. 2, line 65 *et seq.*). KONONOV does disclose a compressed air source connected by connecting lines as part of the device (Figure 1 and relative associated text) (construed to read on an "internal" or "external" reference tank since the compressed air source is part of the device and terminology such as "internal" and "external" are relative terms which are construed broadly). Even if, *arguendo*, one were to construe the compressed air source as being an external tank, the position is taken that it would have been obvious to one having ordinary skill in the

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art at the time the invention was made to rearrange a compressed air source external to a device to an internal location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. If applicant takes the position that the claimed invention requires plural compressed air tanks, the position would be taken that duplicating parts (i.e. compressed air tanks) would be obvious since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8; *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

### ***Conclusion***

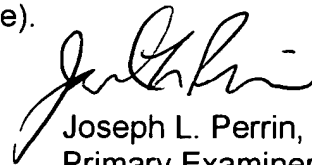
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
5. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is

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(571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joseph L. Perrin, Ph.D.  
Primary Examiner  
Art Unit 1746

jlj